

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Group Art Unit: 3627

Kenneth A. Parulski

Examiner: O'Connor, Gerald J.

LEASING A CONFIGURED
CAMERA SYSTEM

Serial No. 09/534,471

Filed 24 March 2000

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

APPELLANT'S REPLY BRIEF

The Examiner in the Answer on page 3, states that Applicant's statement in the Brief that method claims 1-6 and 9-16 do not stand or fall together is not agreed with because Applicant failed to explain why the claims of each group are believed to be separately patentable.

Claim 9 includes two additional limitations not set forth in independent claim 1. In particular, claim 9 requires establishing a service user account that specifies the selected service that the designee can use and storing in the camera, a service identifier corresponding to the service user account. These two claim elements are not found in independent claim 1. For this reason alone, the claims do not or fall together as these two additional limitations require the Examiner to provide prior art to establish that these elements are taught.

With regard to the arguments directed to claims 17 and 19, wherein the Examiner argues that intended use of the claimed invention must result in the structural difference between the claimed invention and the prior art in order to be patentable and believed distinguished the claimed invention from the prior art. In this regard, Applicant would like to point out that independent claim 17 requires

firmwear for storing service identifier, which identifies a service provider account, the service identifier account specifying the service to be provided by the service provider. Thus, the firmwear memory includes a service identifier. This is a specific structural element that must be provided in the prior art. This service identifier is an integral part of the claimed invention and cannot simply be ignored, simply because the Examiner argues that intended use is not to be considered. In this regard, there is actual software in the camera to provide specific information, i.e. a service identifier. Accordingly, Applicant respectfully submits that this, indeed, is a structural difference that the prior art clearly does not teach or suggest and cannot be ignored.

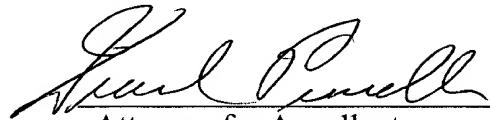
While it is acknowledged that the prior art does not need to be identical words, the prior art still must disclose each and every element of the claimed invention.

In response to Applicant's argument on page 9 of the Answer that there is no teaching or suggestion to modify the prior art, the Examiner states that it has been held that the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art, is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art seeking to solve the same problem. In this regard, the Dell reference is not looking to solve the same problem, but is directed to a totally different and distinct issue, i.e. of selling of customized computer product. This is in contrast to the present invention leasing a configured camera and providing services to a customer. The present invention is directed to providing a particular set of services with regard to images captured by an image capture device and providing the products and services when images are forwarded to the service provider. There is no common based problem that is solved by Dell. The present invention makes it easy for the purchaser of an image capture device to have goods or services automatically produced when images are forwarded to a service provider. The problem is not present in any of the cited references. Accordingly, it would not be obvious to make the modification as suggested by the Examiner. Further, even if the prior art were modified as suggested, it does not teach all of the claimed elements as discussed in Applicant's Brief.

In summary, Applicant respectfully, for the above reasons and the reasons set forth in Applicant's Brief, Applicant respectfully requests that the

Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of claims 1-6 and 9-16.

Respectfully submitted,



Attorney for Appellants
Registration No. 27,370

Frank Pincelli/jpc
Telephone: 585-722-3335
Facsimile: 585-477-4646

Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.